

### **REMARKS/ARGUMENTS**

In the Office Action mailed February 7, 2008, claims 1, 6, 10 and 14 stand rejected under 35 U.S.C. § 102. Claims 2-5, 7-9, 11-13 and 15-24 stand rejected under 35 U.S.C. § 103. Claims 1, 10, 14, 17 and 18 have been amended. Claims 3 and 16 have been canceled. Claims 25-28 have been added. Support for new claims 25-28 may be found in Applicant's Specification in at least paragraph [49] of the present application.

Thus, claims 1, 2, 4-15 and 17-28 are pending. Applicant respectfully responds to the Office Action.

#### **I. Claims 1, 6, 10 and 14 Rejected Under 35 U.S.C. § 102(b)**

Claims 1, 6, 10 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,838,838 to Overton (hereinafter, "Overton"). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicant respectfully submits that the claims at issue, as currently amended, are patentably distinct from Overton. Overton does not disclose all of the limitations in these claims.

Amended claim 1 recites, among other limitations, "identifying a unique pixel or unique pixels in the group of pixels, wherein the unique pixel or pixels comprises the most unique pixel or pixels." Support for this amendment may be found in Applicant's Specification in at least paras. [49] through [51] and Figures 9 and 10 of the present application. In addition, the subject matter of

this amendment was previously contained in original claims 3 and 16. Overton does not disclose this claim subject matter.

In making the rejection against claims 3 and 16, which previously contained the limitations regarding the most unique pixel or pixels, the Office Action suggested that Overton (Col. 3, line 45-Col. 4, line 32) taught this limitation (see Detailed Action, p. 5).

The pertinent portion of Overton states:

If the original byte is determined to part of text, Step 6 determines, for each original pixel to be deleted, whether the pixel to be deleted is black and both its neighboring pixels are white. The pixels immediately to the right and left of the byte are assumed to be white even if, in actuality, they are not. If the criterion is not met, the pixel is simply deleted in Step 5. On the other hand, if the criterion is met, the pixel within the same byte immediately to the right (as seen horizontally across a row of pixels) of the black pixel to be deleted is forced to be black in Step 7. The black pixel to be deleted is then deleted in Step 5 to achieve the desired horizontal scaling. In another embodiment, Step 7 forces the left neighbor to be black instead of the right neighbor.

Overton, Col. 4, lines 1-13.

Thus, the cited portion of Overton actually describes a methodology by which text is preserved during the down-scaling process. This can be clearly seen by the fact that the technique described focuses on maintaining at least one black pixel if the two pixels that are adjacent to the black pixel are both white. Obviously, it would be undesirable to delete such a black pixel and lose that text element in its entirety in the scaled down version of the image.

However, the cited portions of Overton fail to disclose any notion of determining whether certain pixels are the most unique within a group of pixels, as recited in Applicant's independent claims 1, 10, and 14 (emphasis added). This distinction of determining the most unique pixel or pixels is very different from merely deciding which text pixels to delete in order to preserve the text in a smaller size, as shown in Overton. For example, the preserved black pixels in Overton may not be unique since there may be many preserved black pixels within a given group. Rather, the focus of

the methodology of Overton appears to be on preserving what is necessary (and which may also be common) instead of what is most unique, as recited in Applicant's claims.

In view of the foregoing, Applicant respectfully submits that claim 1 is patentably distinct from Overton. Accordingly, Applicant respectfully requests that the rejection of claim 1 be withdrawn because Overton does not disclose all of the subject matter of claim 1.

Claim 6 depends directly from claim 1. Accordingly, Applicant respectfully requests that the rejection of claim 6 be withdrawn.

Amended claims 10 and 14 include subject matter similar to the subject matter of claim 1. As such, Applicant submits that claims 10 and 14 are patentably distinct from Overton for at least the same reasons as those presented above in connection with claim 1 and request that the rejection of these claims be withdrawn.

## **II. Claims 2-4, 11-13, 15, 16, 19 and 23 Rejected Under 35 U.S.C. § 103(a)**

Claims 2-4, 11-13, 15, 16, 19 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Overton in view of U.S. Patent No. 5,754,698 to Suzuki et al. (hereinafter, "Suzuki"). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. \_\_\_, 2007 U.S. LEXIS 4745, at \*\*4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). To establish a *prima facie* case of obviousness, the prior art references "must teach or suggest all the claim limitations." M.P.E.P. § 2142. Moreover, the analysis in support of an obviousness rejection "should be made explicit." KSR, 2007 U.S. LEXIS 4745, at \*\*37. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicant respectfully submits that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the subject matter of these claims.

Claims 2 and 4 depend either directly or indirectly from claim 1. Claim 3 has been canceled, and thus, the rejection as to claim 3 is moot. Accordingly, Applicant respectfully requests that the rejection of claims 2 and 4 be withdrawn.

Claims 11-13 depend either directly or indirectly from claim 10. Accordingly, Applicant respectfully requests that the rejection of claims 11-13 be withdrawn.

Claims 15, 19 and 23 depend either directly or indirectly from claim 14. Claim 16 has been canceled, and thus, the rejection as to claim 16 is moot. Accordingly, Applicant respectfully requests that the rejection of claims 15, 19 and 23 be withdrawn.

### **III. Claims 5, 7-9, 17, 18 and 20-22 Rejected Under 35 U.S.C. § 103(a)**

Claims 5, 7-9, 17, 18 and 20-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Overton in view of Suzuki in further view of U.S. Patent No. 5,097,518 to Scott et al. (hereinafter, "Scott").

Claims 5 and 7-9 depend indirectly from claim 1. Accordingly, Applicant respectfully requests that the rejection of claims 5 and 7-9 be withdrawn.

Claims 17, 18 and 20-22 depend indirectly from claim 14. Accordingly, Applicant respectfully requests that the rejection of claims 17, 18 and 20-22 be withdrawn.

### **IV. Claim 24 Rejected Under 35 U.S.C. § 103(a)**

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Overton in view of Suzuki in further view of U.S. Patent Application Publication No. 2002/0186765 to Morley et al. (hereinafter, "Morley").

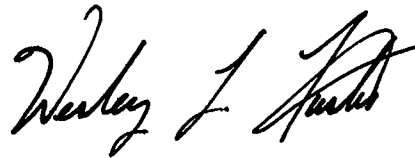
Claim 24 depends indirectly from claim 14. Accordingly, Applicant respectfully requests that the rejection of claim 24 be withdrawn.

Appl. No. 10/800,528  
Amdt. dated April 25, 2008  
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**V. Conclusion**

Applicant respectfully asserts that all pending claims are patentably distinct from the cited references, and requests that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Wesley L. Austin". The signature is fluid and cursive, with the first name "Wesley" being the most prominent.

/Wesley L. Austin/

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